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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

81862.P132

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on _____

Signature _____

Typed or printed name _____

Application Number

09/346,110

Filed

6/30/99

First Named Inventor

Eugene Wang

Art Unit

2667

Examiner

Ly, Anh Vu H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 41,236

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

DANIEL E. OVANEZIAN

Typed or printed name

(408) 720-8300

Telephone number

8/11/05
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Eugene Wang et al.

Application No.: 09/346,110

Filed: June 30, 1999

For: COMMON BACKPLANE FOR
PHYSICAL LAYER SYSTEM
AND NETWORKING LAYER
SYSTEM.

Examiner: Ly, Anh Vu H.

Art Unit: 2667

Confirmation No.: 2024

Mail Stop AF
Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sirs:

In response to the final Office Action mailed on March 29, 2005, and in concurrence with the Applicants' Notice of Appeal filed herewith, applicants hereby submit this pre-appeal brief request for review in the above-captioned case.

FIRST CLASS CERTIFICATE OF MAILING

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REMARKS

ISSUES

- (1) The examiner omitted one or more elements recited in the claims 12-31 and 33-50 that are needed for a prima facie rejection, and/or
- (2) There is a clear error in the examiner's rejection of claims 12-31 and 33-50.

ARGUMENTS

1. Examiner Omitted One or More Elements Needed for a Prima Facie Rejection

A. Claims 12-15, 33-37, 39-46, and 48-50

In regards to claims 12-15 and 33-37, said claims include the limitation of “each of said adapter card interfaces having an arrangement of inputs and outputs to functionally mate to an ATM adapter card and to functionally mate to a SONET adapter card.” Claims 45-46 and 48-50 include the limitation of “functional mating means that functionally mate to an ATM adapter card and that functionally mate to a SONET adapter card.” Such elements are absent from the cited Noh reference.

The examiner has not identified any disclosure in Noh to support his assertion that Noh discloses adapter card interfaces having an arrangement of inputs and outputs to functionally mate to an ATM adapter card and to functionally mate to a SONET adapter card. (e.g., see 3/29/05 Office Action page 3, lines 12-16). Rather, the examiner draws an unsubstantiated conclusion about what is disclosed in the ATM transport scheme of Fig. 5A of Noh. The examiner merely states that “there is rely traffic” and then paraphrases the applicants' claim language in an improper attempt to allege disclosure of applicants noted claim limitation. (e.g., see 3/29/05 Office Action page 9, line 20 to page 10, line 2).

Nothing in Noh describes, teaches or suggests the use of adapter cards or the ability of the scheme to functionally mate one arrangement of input/outputs to two different cards. Furthermore, it is submitted that Fig. 5A of Noh discloses that two separate fabrics, both an STM cross connect fabric 30 and an ATM fabric 85, are needed in the hybrid scheme to combine both STM and ATM traffic. Accordingly, separate switch cards (via fabric 30 and fabric 85) are needed to interface with the ATM channel and the STM channel. Figure 5A of Noh shows a conceptual view of its STM/ATM VP (VPX) cross-connect fabrics. There are no details given on how the backplane is expected to provide cross-connecting traces, whether at STM level, ATM cell level or at the VP layer between the STM and ATM modules. Nothing in Noh discloses that STM fabric 30 can be coupled to an ATM channel or that ATM fabric 85 can be coupled to an STM channel.

B. Claims 21 and 27-30

In regards to claims 21 and 27-30, the examiner has not provided any supporting citation to Noh to support his assertion that Noh discloses integrating a first backplane into an ATM system that does not comprise any SONET switch cards and integrating said second backplane into a SONET system that does not comprise any ATM switch cards. (e.g., see 3/29/05 Office Action page 4, lines 5-15). Rather, the examiner draws an unsubstantiated conclusion about what is disclosed in the ATM transport scheme of Fig. 5A of Noh. It is submitted that Noh is completely silent as to its backplane. Furthermore, it appears any purported disclosure of a backplane in Noh would comprise both the ATM switch cards and STM switch cards as shown in Fig. 5A of Noh.

C. Claim Rejections under 35 U.S.C. §103(a)

Claims 16-20, 38, and 47 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Noh. Claims 16-20 depends from claim 12, claim 38 depends from claim 33 and claim 47 depends from claim 45. For reasons similar to those given above with respect to the rejections under 35 U.S.C. § 102(e), it is submitted that 16-20, 38, and 47 are patentable over Noh under 35 U.S.C. §103(a).

Claims 22-26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Noh in view of Tabu. Applicants respectfully disagree with the Office Action's characterization of the references and submit that Tabu fails to cure the deficiencies noted above with respect to claim 21 and, therefore, claims 22-26 are patentable over the cited references.

Claim 31 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Noh in view of the admitted prior art disclosed in the specification in pages 1-9. Applicants respectfully disagree with the Office Action's assertions and submit that for reasons similar to those given above with respect to claim 21, it is submitted that dependent claim 31 is patentable over Noh.

2. Clear Error in the Examiner's Rejection

A. No Inherency Argument, Nor Rational or Evidence Provided in Support thereof.

The Examiner has not argued that applicants' noted claim limitations are inherently disclosed by Noh and has failed to address applicants' argument on this point (see Applicants' Response to Office Action, 1/12/04, page 14, lines 22-25). If the Examiner is to purport that applicants' noted claim limitations are inherently disclosed by Noh, it is submitted that the Examiner has failed to provide a rational or evidence tending to show inherency (see MPEP 2112.IV). The Examiner was respectfully reminded that the fact that a certain characteristic may

be present in a reference is not sufficient to establish the inherency of such. Inherency may not be established by probabilities or possibilities. (See MPEP 2112).

B. Noh Reference Does Not Provide an Enabling Disclosure

It is also submitted that claim limitations cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabling. Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education and Research, 346 F.3d 1051, 1054 (Fed. Cir. 2003). The examiner's reliance on Figure 5A of Noh is not an enabling disclosure to operate as prior art for the purpose purported by the examiner.

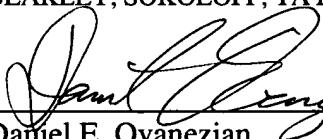
REQUEST FOR PANEL DECISION FOR FINDING 3 THAT THE APPLICATION IS ALLOWED ON THE EXISTING CLAIMS.

In conclusion, applicants respectfully submit that in view of the arguments, the application is allowable on the existing claims.

If there are any additional charges, please charge our Deposit Account No. 02-2666.
Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 8/11, 2005


Daniel E. Ovanezian
Registration No. 41,236

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300